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Jean-Marc Zimmerman
226 St. Paul Street
Westfield, NJ 07090

EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SW

Office Action Summary	Application No. 09/833,956	Applicant(s) LIN-HENDEL, CATHERINE	
	Examiner Andrew J. Fischer	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Acknowledgments

1. The petition filed April 21, 2003 (Paper No. 4) is acknowledged. The petition has been granted (See Paper No. 6).

Drawings

2. The drawings are objected to under 37 C.F.R. §1.83(a). The drawings must show every feature of the invention specified in the claims. No new matter allowed. The following must be shown or the features canceled from the claim(s):

a. The “means for simultaneously conducting a search” as recited in claim 1.

3. The Examiner notes the claims are replete with the above drawing errors since the drawing consist of a single flowchart.¹ All structural elements recited in claims 1-17 are clearly not shown in the drawings. The Examiner highly recommends Applicant review all 17 claims to ensure that every structural element claimed is shown in the drawings. Additionally, a proposed drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

¹ See *e.g. Medical Instrumentation and Diagnostics Corp. v. Elekta AB*, 68 USPQ2d 1263, 1270 (Fed. Cir. 2003)(noting that by only showing a flowchart in the drawings, the drawings failed to disclose *any* structure: “If the box in Figure 1 labeled ‘Image Format Conversion’ actually referred to some structure instead of simply referring to a step in the claimed method, then the situation may well be different.”).

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Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1), MPEP §608.01(o), and MPEP §2181.

Correction of the following is required:

- a. The “means for simultaneously conducting a search” as recited in claim 1.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims do not produce a “useful, concrete, tangible result.”

AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1453 (Fed. Cir. 1999); *In re Warmerdam*, 33 F3d 1354, 31 USPQ2d 1754 (Fed Cir 1994).² Under the broadest reasonable interpretation, *infra*, Applicant’s single means claim is software and therefore not imbedded within a tangible medium. See *e.g.* claim 2.

² To help understand the USPTO’s position on §101 issues, see USPTO’s “35 U.S.C. 101 Training Materials” available at <http://www.uspto.gov/web/menu/pbmethod>.

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Claim Rejections - 35 USC §112 2nd Paragraph

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-17 are rejected under 35 U.S.C. 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 1 recites a single “means for” element. Because such claims are not allowable under 35 U.S.C. §112 6th paragraph, the scope of this claim is unclear.

b. In claim 15, it is unclear if the phrase “means prompts the user to exclude certain ones of the plurality of items” is a different function or additional function performed by the means. On its face, it appears to be a different function. Appropriate correction is required.

c. Also in claim 1, it is unclear what is the corresponding structure and the equivalents of the “means for simultaneously conducting a search.”

Applicant is reminded, “For claim clauses containing functional limitations in ‘means for’ terms pursuant to §112 ¶ 6, the claimed function and its supporting structure in the specification must be presented with sufficient particularity to satisfy the requirements of §112 ¶ 2.” *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1367, 59 USPQ2d 1745, 1747 (Fed. Cir. 2001) (citations omitted). In other words, “[f]ailure to describe adequately the necessary structure, material, or acts corresponding to a means-plus-function limitation in the written description means that the drafter has failed to comply with Section 112, Para. 2.” *Atmel Corp. v. Information Storage*

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Devices, Inc., 198 F.3d 1374, 1380 53 USPQ2d 1225, 1229 (Fed. Cir. 1999) citing *In re Dossel*, 115 F.3d 942, 945, 42 USPQ2d 1881, 1884 (Fed. Cir. 1997)).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

10. Claims 1-17, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Voorhees et. al. (U.S. 5,864,845)(“Voorhees”). Voorhees discloses searching the Internet (the world-wide-web) with Alta Vista, Excite, or other search engine wherein the user specifies the plurality of items to be searched (the user specifies what is to be searched in the form of keyword searches). This is a common search engine; the selectively specifies at least one of the plurality of data sources to be searched (by selecting which particular search engine is used); the search results are displayed in lists (inherent); the user can purchase one or more products

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(inherent in the Internet); and the user can prioritize the order (by selecting a particular search engine first, then searching using another search engine second.

11. The Examiner notes that claim 1 begins “A system” Moreover, all dependent claims being “The system according to claim [1, 2, 6, 7, or 8]” With respect to these claims, the Examiner notes that “A system is an apparatus.” *Ex parte Fressola*, 27 USPQ2d 1608, 1611 (B.P.A.I. 1993)(citations omitted). Additionally, “[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a ‘machine.’” *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Therefore, the Examiner finds that Applicant’s combination “system” claims are “product,” “apparatus,” or more specifically, “machine” claims.³

12. In light of the above fact that Applicant has chosen product claims, functional recitations using “for” only (e.g. “for a plurality of items on a plurality of data sources” as recited in claim 1) in the claims have been considered but are given less patentable weight⁴ because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed

³ Products may be either machines, manufactures, or compositions of matter. MPEP §2106 IV B. 2 (a).

⁴ See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).

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limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115.

Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

13. After careful review of the specification, the Examiner is unaware of any desire—either expressly or implicitly—by Applicant to be his own lexicographer and to define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore, the Examiner starts with the heavy presumption that all claim limitations are given their ordinary and accustom meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a “heavy presumption that a claim term carries its ordinary and customary meaning.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).⁵

⁵ It is the Examiner’s position that “plain meaning” and “ordinary and accustom meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

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In accordance with the ordinary and accustom meaning presumption, during examination the claims are interpreted with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁶

However, if Applicant disagrees with the Examiner and has either (a) already used lexicography or (b) wishes to use lexicography and therefore (under either (a) or (b)) desires a claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests Applicant in his next response to expressly indicate⁷ the claim limitation at issue and to show where in the specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term”).⁸ The Examiner cautions that no new matter is allowed.

⁶ See also MPEP §2111.

⁷ “Absent an *express intent* to impart a novel meaning, terms in a claim are to be given their ordinary and accustomed meaning. [Emphasis added.]” *Wenger Manufacturing Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1232, 57 USPQ2d 1679, 1684 (Fed. Cir. 2001) (citations and quotations omitted). “In the absence of an *express intent* to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning. We indulge a heavy presumption that a claim term carries its ordinary and customary meaning. [Emphasis added.]” *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002) (citations and quotations omitted).

⁸ See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[A] patentee may choose to be his own lexicographer and use terms in a

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Failure by Applicant in his next response to address this issue in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicant to forgo lexicography in this application and to continue having the claims interpreted with their broadest reasonable interpretation. Additionally, it is the Examiner's position that the above requirements are reasonable.⁹ Except for the discussion on 35 U.S.C. §112 6th paragraph noted below, the preceding discussion on claim interpretation principles applies to all examined claims currently pending.

14. To the extent that the Examiner's interpretations are in dispute with Applicant(s)' interpretations, the Examiner hereby adopts the following definitions—under the broadest reasonable interpretation standard—in all his claim interpretations.¹⁰ Moreover, while the

manner other than their ordinary meaning, *as long as* the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]"); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) ("Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention."). See also MPEP §2111.01, subsection titled "Applicant May Be Own Lexicographer" and MPEP §2173.05(a) titled "New Terminology."

⁹ The requirements are reasonable on at least two separate and independent grounds. First, the Examiner's requirements are simply an express request for clarification of how Applicant intends his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant is not inadvertently overlooked by the Examiner. Second, the requirements are reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed November 2, 2003).

¹⁰ While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts

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following list is provided in accordance with *In re Morris*, the definitions are a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language.¹¹

Finally, the following list is not intended to be exhaustive in any way:

a. **Server:** “2. On the Internet or other network, a computer or program that responds to commands from a client.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.¹² **Client:** “3. On a local area network or Internet, a computer that accesses shared network resources provided by another computer (called a *server*).” *Id.* **Computer:** “Any machine that does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output.” *Id.*

b. **Data** “Plural of the Latin *datum*, meaning an item of information. In practice, data is often used for the singular as well as plural the form of the noun.” *Id.*

found in the definitions themselves or in the prior art.

¹¹ See e.g. *Brookhill-Wilk I LLC v. Intuitive Surgical Inc.*, 334 F.3d 1294, 1300, 67 USPQ2d 1132, 1137 (Fed. Cir. 2003) (abstract dictionary definitions are not alone determinative; “resort must always be made to the surrounding text of the claims in question”).

¹² Based upon Applicant’s disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner’s finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See e.g. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used *Microsoft Press Computer Dictionary* (3d ed.) as “a technical dictionary” used to define the term “flag.” See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled “New Terminology”.

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- c. **Database** “A file composed of records, each containing fields together with a set of operations for searching, sorting, recombining and other functions.” *Id.*
- d. **Device** “A generic term for a computer subsystem. Printers, serial ports, and disk drives are often referred to as devices; such subsystems frequently require their own controlling software called device drivers.” *Id.*
- e. **Network**: “A group of computers and associated network devices that are connected by communications facilities.” *Id.*
- f. **Web site** “A group of related HTML documents and associated files, scripts, and databases that is served up by an HTTP server on the World Wide Web. The HTML documents in a Web site generally cover one or more related topics and are interconnected through hyperlinks. Most Web sites have a home page as their starting point, which frequently functions as a table of contents for the site. Many large organizations, such as corporations, will have one or more HTTP servers dedicated to a single Web site. However, an HTTP server can also serve several small Web sites, such as those owned by individuals. Users need a Web browser and an Internet connection to access a Web site.” *Id.* **HTTP Sever** “1. Server software that uses HTTP to serve up HTML documents and any associated files and scripts when requested by a client, such as a Web browser. The connection between client and server is usually broken after the requested document or file has been served. HTTP servers are used on Web and Intranet sites. *Also called* Web Sever 2. Any machine on which an HTTP server program is running.” *Id.*

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35 U.S.C. 112 6th paragraph

15. The pending system claims (*i.e.* the dependent claims reciting both a means-plus-function element in addition to other structural elements as required by the single means phrase in 35 U.S.C. 112 6th paragraph with the additional structure found predominantly in the dependent claims) are combination claims made of old and possibly new elements. See *e.g. Clearstream Wastewater Sys. v. Hydro-Action, Inc.*, 206 F.3d 1440, 1446, 54 USPQ2d 1185, 1190 (Fed. Cir. 2000)(noting that there is “a general rule that combination claims can consist of combinations of old elements as well as new elements”). Moreover, in combination claims, there is no essential element or “gist” of the invention. *Cooper Cameron Corp. v. Kvaerner Oilfield Products Inc.*, 62 USPQ2d 1846, 1850 (Fed. Cir. 2002) (noting that “there is no legally recognizable or protected ‘essential’ element, ‘gist’ or ‘heart’ of the invention in a combination patent.”). In light of this fact and after further review of the specification, the Examiner finds that the *single* means-plus-function limitation in claim 1 is *not* determinative of patentability. In other words, the Examiner finds that the means-plus-function limitation in the claims is not the *only* point of novelty; the means-plus-function limitations are *not* the only new element(s) in the claim(s). The Examiner therefore begins his §112 6th paragraph analysis with this presumption.

16. If Applicant disagrees with this presumption, the Examiner respectfully requests Applicant to expressly traverse the Examiner’s presumption in his next response and provide appropriate arguments in support their of. Failure by Applicant to also address this issue in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by

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Applicant to maintain the presumption that the means-plus-function limitations are *not* the claim(s)' only point of novelty.

17. The following is a more detailed analysis of 35 U.S.C. 112 6th paragraph limitation now pending.

Means Phrase #1

Invocation

18. It is the Examiner's position that the phrase "means for simultaneously conducting a search" as recited in claim 1 ("Means Phrase #1") is an attempt by Applicant to invoke 35 U.S.C. 112 6th paragraph in claim 1.

Invocation Prong 1:

a. First, in accordance with the MPEP §2181, the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6th* ("Guidelines")¹³, and *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 1318, 50 USPQ2d 1161, 1166 (Fed. Cir. 1999),¹⁴ Applicants use of "means for" in claim 1 creates a rebuttable presumption that tends to invoke 35 U.S.C. 112 6th paragraph. "It is well settled that a claim limitation that actually uses the

¹³ Federal Register Vol 65, No 120, June 21, 2000.

¹⁴ See also *Sage Prods., Inc. v. Devon Industry, Inc.*, 126 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997); *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 USPQ2d 1783, 1785 (Fed. Cir. 1996).

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word ‘means’ invokes a rebuttable presumption that § 112, ¶ 6 applies. . . . The term ‘means’ is central to the analysis.” *Apex Inc. v. Raritan Computer Inc.*, 66 USPQ2d 1444, 1450 (Fed. Cir. 2003) (internal citations and quotations omitted). Since “means for” is recited in Means Phrase #1, this step is clearly met.

Invocation - Prong 2:

b. Second, in accordance with MPEP §2181, the Guidelines, and *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001), the Examiner finds that Applicant recites a corresponding function to the means—“simultaneously conducting a search.”

The Examiner notes that when determining the function recited “[u]nless something in the written description suggests that the patentee intended the unambiguous language to be construed in a manner inconsistent with its ordinary meaning, we are bound by that language.” *Telemac Cellular Corp. v. Topp Telecom Inc.*, 58 USPQ2d 1545, 1550 (Fed. Cir. 2001). Because nothing in the specification suggests otherwise, the function as found in the Means Phrase #1 will have its ordinary meaning.

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Invocation - Prong 3:

c. Third, in accordance with MPEP §2181, the Guidelines, and *Personalized Media Communications, LLC v. International Trade Commission*, 161 F.3d 696, 704, 48 USPQ2d at 1880, 1887 (Fed. Cir. 1998), the means-plus-function clause must not recite sufficient definite structure for performing that function.

In our case, Means Phrase #1 does not recite the structural elements which perform the function. In determining whether the presumption of invocation is rebutted, “the focus remains on whether the claim ... recites sufficiently definite structure.” *Id.* Furthermore, sufficient structure does not require an exhaustive recitation—only structure to perform entirely the claimed function. *Rodime PLC v. Seagate Technology Inc.*, 174 F.3d 1294, 1304, 50 USPQ2d 1429, 1436 (Fed. Cir. 1999). Because claim 1 is a single means claim, the “simultaneously conducting a search” is the only claimed element making analyzation of any structure found in claim 1 moot.

Because of the above, the Examiner finds that Means Phrase #1 invokes 35 U.S.C. 112 6th paragraph.

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Corresponding Structure, Material, or Acts

19. In accordance with MPEP §2181, the Guidelines (section “II”) and *Medtronic, Inc., v. Advanced Cardiovascular Systems, Inc.* 248 F.3d 1303, 58 USPQ2d 1607, 1614 (Fed. Cir. 2001), “[t]he next step is to determine the corresponding structure described in the specification and equivalents thereof. Structure disclosed in the written description is ‘corresponding’ to the claimed means under 35 U.S.C. 112 6th paragraph only if the structure is clearly linked by the written description” *Id.*

One of ordinary skill in the art however can not recognize the corresponding structure in this case. Neither the figures nor the specification clearly links the means plus function claim limitation to any corresponding structure. The Examiner notes that although some dependent claims may shed light on what is and what is not the corresponding structure (e.g. claim 2 recites “the means are implemented using software), this evidence is not conclusive for at least claim 1. “While it is true that dependent claims can aid in interpreting the scope of claims from which they depend, they are only an aid to interpretation and are not conclusive. The dependent claim tail cannot wag the independent claim dog.” *North American Vaccine v. American Cyanamid Co.*, 7 F.3d 1571, 1577, 28 USPQ2d 1333, 1337 (Fed. Cir. 1993).

Conclusion

20. The prior art made of record considered pertinent to Applicant(s)’ disclosure includes the following: Aridor et. al. (U.S. 6,636,848 B1); Ryan et. al. (U.S. 6,421,675 B1); Cochran (U.S.

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6,345,273 B1); Neal et. al. (U.S. 6,324,534 B1); Singhai (U.S. 6,370,527 B1); Campbell et. al. (U.S. 6,012,055 A); Bowman et. al. (U.S. 6,006,225 A); and Corey et. al. (U.S. 5,987,446 A).

21. The following two (2) citations to the Manual of Patent Examining Procedure (“MPEP”) apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8th Edition, Rev 1, February 2003. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

22. Suggestions or examples of claim language provided by the Examiner in this Office Action are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment that incorporates an Examiner suggestion or example or simply changes claim interpretation will still require further consideration and/or search and a patentability determination as noted above.

23. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet Works, Millennium Ed. by Preston Gralla are additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety.

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Moreover, because these three references are directed towards beginners (see *e.g.* “User Level Beginning . . .”), because of the references’ basic content (which is self-evident upon review of the references), and after further review of both the intrinsic evidence of record and the entire art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these three references are primarily directed towards those of low skill in this art. Because these three references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of the knowledge and information contained within these three references.

24. It is the Examiner’s factual determination that all limitations in claims 1-17 have been considered and are either disclosed or inherent in the references as discussed above. Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) (“Preponderance of the evidence is the standard that must be met by the PTO in making rejections.” (citations and quotations omitted)). The preceding discussion in this paragraph regarding the standard for claim rejections applies to all examined claims currently pending.

25. In accordance with the USPTO’s goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicant with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. If Applicant disagrees with *any* factual determination or

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legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹⁵ the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) *in his next response*. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. To respond to this Office Action by facsimile, fax to (703) 872-9306.



Andrew J. Fischer
Patent Examiner

AJF
November 2, 2003

¹⁵ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.